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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,892	12/14/2000	Takayuki Yamamoto	Q62230	5759

7590

02/05/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 02/05/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the *EXAMINER* in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

See attached NOTE.

4. ☒ Applicant's reply has overcome the following rejection(s):

See attached NOTE.

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: None
- Claim(s) objected to: _____
- Claim(s) rejected: 1, 2, 5
- Claim(s) withdrawn from consideration: _____
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900

Daniel Zinker

1700

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NOTE

The Examiner has the following observations to make in connection with his non-entry of the recently submitted Amendment under Rule 116. Initially it is noted that the 35 U.S.C. § 112, second paragraph rejection of claims 1, 2 and 5 would have been overcome by applicants' response. As to the prior art rejections which would not have been rendered moot by applicants' proposed response, the following observations are deemed pertinent. Claim 5 would now have been an independent method claim, but the substance of the pending rejection set forth in paragraph No. 5 of the final rejection would still be entirely appropriate, since applicants' claim amendments simply consisted of writing out claim 1 into claim 5. As such, the prior art rejection of this claim as unpatentable under 35 U.S.C. § 103(a) in view of EP -470 taken in view of applicants' admissions in the specification is still deemed to be entirely appropriate. Applicants sole observation is (Response, page 6, first complete paragraph) that "EP -470 does not teach or suggest the present claimed invention, as defined by claim 5", but this argument fails to take account of the fact that a prior art combination rejection has been relied upon. With respect to claim 2, making this a dependent method claim, instead of a formerly dependent article claim, would require the Examiner to now reject the claim (further also containing a product-by-process limitation) as obvious over the

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prior art combination of EP -470 in view of applicants' admissions in the specification, substantially as set forth in the pending rejection of claim 5. As such, this would be a "new grounds of rejection" and as such the Examiner could not properly continue the final rejection of record, so he is forced to not enter the submitted amendment even though he respectfully submits that otherwise rejecting the response would be routine. As such, it is again respectfully noted that non-entry of the amendment appears to be the Examiner's only logical alternative.

Dzirker:cdc

(703) 308-0031

February 4, 2003